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MAR 14 2011
OFFICE OF PETITIONS

In re Application of	:	DECISION ON REQUEST
Ravi I. Sharma	:	FOR RECONSIDERATION OF
Application No. 10/528164	:	PATENT TERM ADJUSTMENT
Filing or 371(c) Date: 07/23/2008	:	AND
Attorney Docket Number:	:	NOTICE OF INTENT TO ISSUE
1038.1001	:	CERTIFICATE OF CORRECTION

This is a decision on the "Request for Reconsideration of Patent Term Adjustment Under 37 C.F.R. § 1.705(B)," filed September 13, 2010. Applicants request reconsideration of the patent term adjustment to at least nine hundred ninety-eight (998) days. Applicant requests this recalculation (1) in connection with the abandonment of the application; (2) in connection with the filing and replies to a petition to withdraw the holding of abandonment; (3) in connection with a delay in the mailing of a Notice of Abandonment; (4) in connection with the failure of the Office to timely notify applicant of non-receipt of the application filing fee; (5) in connection with misinformation provided to applicant, and (6) in connection with unreasonably long delays upon revival of the application in connection with the mailing of a Notice to File Missing Requirements, and in connection with assigning the application to an examiner, and forwarding the application to an examiner, and in issuing a first Office action. The request is properly treated under 37 CFR 1.705(b).

The Request for Reconsideration of Patent Term Adjustment ("PTA") under 37 CFR 1.705(b), is **GRANTED TO THE EXTENT INDICATED HEREIN.**

BACKGROUND

On May 28, 2010, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is zero (0) days.

On September 13, 2010, Applicants timely submitted the present request for reconsideration of patent term adjustment¹. Applicants do not dispute the reduction to date of 39 days pursuant to 37 CFR 1.704(b).

¹ Office records show that the Issue Fee payment was received in the Office on September 13, 2010.

Applicant files the present petition and requests a just and equitable accounting, in terms of patent term adjustment, based upon (1) a three hundred and eighteen day delay from applicant's submission of the application on March 14, 2005 to January 26, 2006, the actual date of abandonment; (2) a seventy-four day delay from abandonment of the application on January 26, 2006 to the mailing of a Notice of Abandonment on April 10, 2006; (3) a two-hundred fifty-eight day delay from revival of the application on August 23, 2007, to the mailing of a Notice to File Missing Requirements on May 8, 2008; (4) a six hundred and six day delay from applicant's filing of a petition to withdraw the holding of abandonment on November 19, 2006 to July 18, 2008, the date the Office of Patent Cooperation Treaty ("PCT") putatively withdrew a previous Withdrawal of Notice of Abandonment dated April 10, 2006; and/or (5) a seven hundred forty-six day delay from revival of the application on August 23, 2007 to the mailing of a Restriction Requirement on September 8, 2009.

OPINION

Applicants' arguments have been carefully considered. Applicant is advised that under 35 U.S.C. § 154(b)(1), an applicant is entitled (subject to certain conditions and limitations) to a patent term adjustment for the following reasons: (1) If the USPTO fails to take certain actions during the examination and issue process within specified time frames (35 U.S.C. 154(b)(1)(A)), which are known as "A" delays; (2) If the USPTO fails to issue a patent within three (3) years of the actual filing date of the application (35 U.S.C. 154(b)(1)(B)), which are known as "B" delays, and (3) for delays due to interference, secrecy order, or successful appellate review (35 U.S.C. 154(b)(1)(C)), which are known as "C" delays. (Emphasis added).

37 CFR § 1.705(b), provides as follows:

Any request for reconsideration of the patent term adjustment indicated in the notice of allowance, except as provided in paragraph (d) of this section, and any request for reinstatement of all or part of the term reduced pursuant to § 1.704(b) must be by way of an application for patent term adjustment. An application for patent term adjustment under this section must be filed no later than the payment of the issue fee but may not be filed earlier than the date of mailing of the notice of allowance. An application for patent term adjustment under this section must be accompanied by:

- (1) The fee set forth in § 1.18(e); and
- (2) A statement of the facts involved, specifying:
 - (i) The correct patent term adjustment and the basis or bases under § 1.702 for the adjustment;
 - (ii) The relevant dates as specified in §§ 1.703(a) through (e) for which an adjustment is sought and the adjustment as specified in § 1.703(f) to which the patent is entitled;
 - (iii) Whether the patent is subject to a terminal disclaimer and any expiration date specified in the terminal disclaimer; and
 - (iv)

(A) Any circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704; or

(B) That there were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704.

(c) Any application for patent term adjustment under this section that requests reinstatement of all or part of the period of adjustment reduced pursuant to § 1.704(b) for failing to reply to a rejection, objection, argument, or other request within three months of the date of mailing of the Office communication notifying the applicant of the rejection, objection, argument, or other request must also be accompanied by:

(1) The fee set forth in § 1.18(f); and

(2) A showing to the satisfaction of the Director that, in spite of all due care, the applicant was unable to reply to the rejection, objection, argument, or other request within three months of the date of mailing of the Office communication notifying the applicant of the rejection, objection, argument, or other request. The Office shall not grant any request for reinstatement for more than three additional months for each reply beyond three months from the date of mailing of the Office communication notifying the applicant of the rejection, objection, argument, or other request.

(Emphasis added).

The present petition is properly filed to request for reconsideration of the patent term adjustment indicated in the notice of allowance; however, the present petition fails to provide the basis or bases under § 1.702 for the requested adjustment.

The applicable Rule, 37 CFR 1.702, Grounds for adjustment of patent term due to examination delay under the Patent Term Guarantee Act of 1999 (original applications, other than designs, filed on or after May 29, 2000), provides for an adjustment of the patent term as follows:

(a) Failure to take certain actions within specified time frames.

Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

(1) Mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 in an international application;

(2) Respond to a reply under 35 U.S.C. 132 or to an appeal taken under 35 U.S.C. 134 not later than four months after the date on which the reply was filed or the appeal was taken;

(3) Act on an application not later than four months after the date of a decision by the Board of Patent Appeals and Interferences under 35 U.S.C. 134 or 135 or a

decision by a Federal court under 35 U.S.C. 141, 145, or 146 where at least one allowable claim remains in the application; or
(4) Issue a patent not later than four months after the date on which the issue fee was paid under 35 U.S.C. 151 and all outstanding requirements were satisfied.

A review of the present petition reveals that the petition does not request an adjustment of the patent term based upon 37 CFR 1.702. While it is noted that petitioner avers that there was a seven hundred forty-six day delay from revival of the application on August 23, 2007 to the mailing of a Restriction Requirement on September 8, 2009, as stated supra in 37 CFR 1.702(a)(1), the Office has 14 months from the date the application fulfilled the requirements of 35 U.S.C. 371, within which to mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151. Here, applicant fulfilled the requirements of 35 U.S.C. 371 on July 23, 2008. The Office mailed a Restriction Requirement on September 23, 2009, within 14 months of applicant fulfilling the requirements of 35 U.S.C. 371 on July 23, 2008.

Applicant's requests for adjustment of the patent term of three hundred and eighteen days, from applicant's submission of the application on March 14, 2005 to January 26, 2006, the actual date of abandonment; (2) seventy-four days, from abandonment of the application on January 26, 2006 to the mailing of a Notice of Abandonment on April 10, 2006; (3) two-hundred fifty-eight days, from revival of the application on August 23, 2007, to the mailing of a Notice to File Missing Requirements on May 8, 2008, and (4) six hundred and six days, from applicant's filing of a petition to withdraw the holding of abandonment on November 19, 2006 to July 18, 2008, the date the Office of Patent Cooperation Treaty ("PCT") putatively withdrew a previous Withdrawal of Notice of Abandonment dated April 10, 2006, are not properly addressed in a petition under 37 CFR 1.705(b).

Applicant is further advised that a petition under 37 CFR 1.705(d) is filed to request reconsideration of the patent term adjustment indicated in the patent, and it is this petition that appropriately addresses the Office's failure to issue a patent within 3 years². However, knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of

² The period of adjustment under 35 U.S.C. 154(b)(1)(B) and 37 CFR 1.702(b) is the number of days in the period beginning on the day after the date that is three years after the date on which the national stage commenced under 35 U.S.C. 371(b) or (f)). See MPEP § 2730. The commencement date is the date 30 months from the earliest priority date claimed in the international application. (The commencement date may be earlier than 30 months where (1) an applicant expressly requested early commencement, and completed all requirements under 35 U.S.C. 371(c), or (2) Demand was timely filed requesting a change in commencement from 20 to 30 months).

the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee³.

Finally, a review of the application file reveals that the Office neglected to assess a reduction in connection with the abandonment and revival of the present application pursuant to 37 CFR §§ 1.704(c)(3) and (4), to the extent that the periods are not overlapping.

Pursuant to 37 CFR 1.704(c)(3), the period of delay begins on the date of abandonment – here, the application became abandoned for failing to pay the Basic National Fee by the 30 month date, January 25, 2006, and the date of abandonment is January 26, 2006, and ends on the earlier of (i) the date of mailing of the decision reviving the application (i.e. April 23, 2007) or (ii) the date that is four months after the date the grantable petition to revive the application was filed (i.e. August 26, 2007), or 452 days⁴. (Emphasis supplied).

In view thereof, the correct Patent Term Adjustment at the time of the mailing of the Notice of Allowance remains zero (0) days (adjustments totaling zero (0) days less reductions totaling 491 days (452 days + 39 days), subject to any terminal disclaimer.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

³ For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the § 1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

⁴ Pursuant to 37 CFR 1.704(c)(4), a reduction is properly assessed for the failure to file a petition to withdraw the holding of abandonment or to revive an application within two months from the mailing date of a notice of abandonment, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date two months from the mailing date of a notice of abandonment, June 11, 2006, and ending on the date a petition to withdraw the holding of abandonment or to revive the application was filed, November 20, 2006, or 224 days. However, the reduction pursuant to 37 CFR 1.704(c)(4) overlaps with the period of reduction pursuant to 37 CFR 1.704(c)(3).

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and **must** include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this matter should be directed to Attorney Derek Woods at (571) 272-3232.



Anthony Knight
Director
Office of Petitions



Patent Term Adjustments



PTA/PTE Information Patent Term Adjustment Patent Term Extension

Application Number*: 10528164 Search Explanation of PTA Calculation Explanation of PTE Calculation

PTA Calculations for Application: 10528164

Application Filing Date 07/23/2008	Overlapping Days Between (A and B) or (A and C) 0
Issue Date of Patent	Non-Overlapping USPTO Delays: 0
A Delays 0	PTO Manual Adjustment -452
B Delays 0	Applicant Delay (APPL) 39
C Delays 0	Total PTA (days) 0

* - Sorted Column

File Contents History

Action Number	Action Recorded Date	Action Due Date	Action Code	Action Description	Duration PTO	Duration APPL	Parent Action Number
121	03/11/2011		P028	Adjustment of PTA Calculation by PTO		452	0
103	05/28/2010		MN/ =	Mail Notice of Allowance			0
102	05/27/2010		IREV	Issue Revision Completed			0
101	05/27/2010		N/ =	Notice of Allowance Data Verification Completed			0
100	05/27/2010		DVER	Document Verification			0
99	05/10/2010		EX.A	Examiner's Amendment Communication			0
98	05/10/2010		CNTA	Allowability Notice			0
95	04/24/2010		FWDX	Date Forwarded to Examiner			0
94	04/09/2010	03/01/2010	A..	Response after Non-Final Action		39	92
93	04/09/2010		XT/G	Request for Extension of Time - Granted			0
92	12/01/2009		MCTNF	Mail Non-Final Rejection			0
91	12/01/2009		CTNF	Non-Final Rejection			0
82	10/30/2009		FWDX	Date Forwarded to Examiner			0
81	10/22/2009		ELC	Response to Election / Restriction Filed			0
80	10/22/2009		XT/G	Request for Extension of Time - Granted			0
79	09/08/2009		MCTRS	Mail Restriction Requirement			0
78	09/03/2009		CTRS	Restriction/Election Requirement			0
75	08/26/2009		DOCK	Case Docketed to Examiner in GAU			0
74	06/01/2009		DOCK	Case Docketed to Examiner in GAU			0
69	02/26/2009		PG-ISSUE	PG-Pub Issue Notification			0
90	02/12/2009		IDSC	Information Disclosure Statement considered			0
73	02/12/2009		RCAP	Reference capture on IDS			0
72	02/12/2009		M844	Information Disclosure Statement (IDS) Filed			0
68	02/12/2009		WIDS	Information Disclosure Statement (IDS) Filed			0
70	01/27/2009		A.PE	Preliminary Amendment			0
66	01/21/2009		MNPR	Mail Non-Compliant Preliminary Amendment			0
65	01/21/2009		TSSCOMP	IFW TSS Processing by Tech Center Complete			0
64	01/21/2009		NPRL	Non-Compliant Preliminary Amendment			0
62	01/21/2009		DOCK	Case Docketed to Examiner in GAU			0
89	01/16/2009		IDSC	Information Disclosure Statement considered			0
84	01/16/2009		RCAP	Reference capture on IDS			0
83	01/16/2009		M844	Information Disclosure Statement (IDS) Filed			0
67	01/16/2009		WIDS	Information Disclosure Statement (IDS) Filed			0
52	12/05/2008		OIPE	Application Dispatched from OIPE			0
50	11/10/2008		PGPC	Sent to Classification Contractor			0
49	11/18/2008		FLRCPT.U	Filing Receipt - Updated			0
48	11/10/2008		M903	Notice of DO/EO Acceptance Mailed			0
61	10/27/2008		A.PE	Preliminary Amendment			0
47	10/27/2008		ADDFLFE	Additional Application Filing Fees			0
45	10/27/2008		PREAMND	Preliminary Amendments			0
44	09/30/2008		FLRCPT.O	Filing Receipt			0
43	09/30/2008		M916	Notice of DO/EO Defective Response Mailed			0
35	09/29/2008		CPYIPER	Copy of the International Preliminary Examination Report			0
33	07/28/2008		NPTDI-1	Mail-Petition Decision - Dismissed			0
32	07/28/2008		PTDI-1	Petition Decision - Dismissed			0
60	07/23/2008		A.PE	Preliminary Amendment			0
51	07/23/2008		371COMP	371 Completion Date			0
42	07/23/2008		ADDFLFE	Additional Application Filing Fees			0
40	07/23/2008		SES	Small Entity Statement (37 CFR 1.27)			0
34	07/23/2008		OATHDECL	A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applicant			0

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